

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Thomas Tuschl et al.

Serial No.: 09/821,832

Confirmation No.: 6240

Filed: March 30, 2001

For: RNA SEQUENCE-SPECIFIC MEDIATORS OF RNAINTERFERENCE

Examiner: L. V. Wollenberger

Art Unit: 1635

Confirmation No.: 6240

MAIL STOP PETITIONS

COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 22313-1450

**RENEWED PETITION TO REVOKE POWER OF ATTORNEY UNDER 37 C.F.R.  
1.36(a)**

Sir:

We write in response to the Petition in Opposition ("Opposition"), filed on July 31, 2009, by the other three co-assignees of the above application ("the co-assignees") to the Petition to Revoke Power of Attorney Under 37 C.F.R. 1.36(a) (the "Max-Planck Petition") filed by Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. ("Max Planck") in the above-referenced patent application, as well as various continuations and divisionals of the above application (collectively, "Tuschl I applications").

It is Max-Planck's position that Wolf Greenfield has been serving as its counsel, as well as for the other co-assignees, in connection with the prosecution of the Tuschl I applications. It is clear that a conflict of interests has developed between Max-Planck and the other co-assignees. That conflict prevents Wolf Greenfield from continuing to represent *any* of the co-assignees, including Max-Planck, in connection with the Tuschl I applications. Wolf Greenfield does not deny that there is such a conflict of interest.

Rather, Wolf Greenfield has taken the narrow position that it is not Max-Planck's attorney—even though it holds a power of attorney from Max-Planck (Appendix A).

Whitehead bases its narrow position that a power of attorney does not *necessarily* create an attorney-client relationship on *Sun Studs v. Applied Theory Assocs.*, 722 F.2d 1557, 1568 (Fed. Cir. 1985). However, *Sun Studs* is not relevant to the current situation. The inventor in *Sun Studs* was obligated to execute a power of attorney to counsel chosen by the assignee of the invention. The inventor did not retain any ownership rights. In contrast, Max-Planck did not give its power of attorney for the benefit of a third party (such as Whitehead), because Max-Planck *retained* an ownership interest in the Tuschl I applications. Thus, Max-Planck's power of attorney was given to Wolf Greenfield for its own benefit, as well as that of the other co-assignees. Max-Planck strongly disagrees with Wolf Greenfield's narrow position that is not Max-Planck's attorney. Indeed, the USPTO Rules make clear that the Opposition is wrong. 37 CFR 1.32(a)(2) defines a power of attorney as:

... a written document by which a principal authorizes one or more patent attorneys or joint inventors to act on his or her behalf.

Section 1.32(a)(3) defines a principal as including an assignee. Max-Planck executed a power of attorney that authorized Wolf Greenfield to act on its behalf in connection with the Tuschl I applications, and thus Max-Planck became a client of Wolf Greenfield.

Wolf Greenfield has presented no facts suggesting that it did anything *for years* to disabuse Max-Planck of that self-evident notion. Under the USPTO rules, Max-Planck could have filed a petition asking to be allowed to select separate counsel. *In re Goldstein*, 16 USPQ2d 1963 (Dep. Ass't Com'r for Patents 1988). Instead, it relied

upon Wolf Greenfield to represent its interests—which Wolf Greenfield does not deny—which is the epitome of an attorney-client relationship.

The power of attorney that Wolf Greenfield requested from Max-Planck contains nothing to suggest that Wolf Greenfield would not be serving as counsel to Max-Planck, and Wolf Greenfield sent no other document to Max-Planck suggesting otherwise (until the present dispute arose). Thus, Max-Planck reasonably assumed that Wolf Greenfield was acting as its attorney. Further, during the years that Wolf Greenfield has acted on Max-Planck's behalf pursuant to the power of attorney, Wolf Greenfield never informed Max-Planck that the parties did not enjoy an attorney-client relationship with all of the protections and benefits such a relationship affords.

Max-Planck certainly paid for those protections and benefits, as the Agreements required. (See Appendix B of the Opposition, Para. 2(a) (“MPG shall reimburse WHITEHEAD for fifty percent (50%)” of the costs of “filing, prosecution, and maintenance” of the Tuschl I cases.). Indeed, it was only within the last year that Wolf Greenfield first told Max-Planck that the firm was not serving (and had never served) as counsel to Max-Planck—and did so only after a clear conflict of interest had developed between Max-Planck and the other three co-assignees of the Tuschl I applications. The Agreements between the co-assignees, stating that Whitehead shall have “primary responsibility” for prosecution of the applications, do not indicate Whitehead is Wolf Greenfield's only client. Indeed, the Agreements suggest just the opposite—that selected counsel will represent *all* of the assignees. (See, e.g., Appendix B of the Opposition, Para. 2(a) (Whitehead shall “allow the REMAINING JOINT OWNERS . . . reasonable opportunity to comment and advise on patent attorneys to be used.”) Nor

do the Agreements prohibit Max-Planck (or any other co-assignee) from selecting its own counsel if counsel chosen by Whitehead is not representing Max-Planck's interests, as Max-Planck has done in its petition. Further, Whitehead has breached the Agreements by repeatedly ignoring advice from Max-Planck, contrary to Max-Planck's expectations when it signed the Agreements and to the very terms of the Agreements, as explained in the litigation papers.

Moreover, Max-Planck's Petition should be granted *regardless of whether Wolf Greenfield had a formal attorney-client relationship with Max-Planck*. Wolf Greenfield has admitted that it is actively representing the interests of the other co-assignees against Max-Planck. Max-Planck should be entitled to have representation in connection with the Tuschl I applications—whether that representation is characterized as an attorney/client relationship or something else—that is not subject to a conflict of interests.

And there can be no doubt that Wolf Greenfield is taking positions adverse to Max-Planck. As just one example, in a letter dated June 25, 2009, from Wolf Greenfield to counsel for Max-Planck in the action against Wolf Greenfield (Appendix B), Wolf Greenfield states:

...Wolf Greenfield has been advising Whitehead with respect to Whitehead's dispute with [Max-Planck].

Nothing could be clearer that Wolf Greenfield is siding with Whitehead in the dispute with Max-Planck over the prosecution of the Tuschl I applications. Moreover, the papers from the litigations of record in this application are replete with explanations of how Wolf Greenfield is representing the interests of the other co-assignees against the interests of Max-Planck. (See Motion for Preliminary Injunction (Dkt. #9), Max-

Planck-Gesellschaft zur Förderung der Wissenschaften E.V., et al. v. Whitehead Institute for Biomedical Research, et al., Civil Action No. 2009-11116-PBS, at 2 (“Max Planck repeatedly has requested that Defendants delete from the Tuschl I patent applications the Tuschl II invention information that belongs solely to Max Planck Society. Defendants have failed and refused—without offering any meaningful justification—to remove Max Planck Society’s Tuschl II inventions from the Tuschl I applications.”), at 7–8 (“On May 29, Defendants demanded that Max Planck Society sign a document to permit a Tuschl I application to issue as a patent containing the Tuschl II inventions. Max Planck Society rightfully refused.”), at 8 (“On June 18, 2009, Whitehead filed documents with the USPTO arguing that (1) the USPTO should allow one of the Tuschl I patent applications because it was earlier filed than the Tuschl II patent applications, and (2) any rejections based on double patenting should be made only to the Tuschl II patent applications. In complete violation of its contractual and fiduciary obligations, Whitehead did not consult with or inform Max Planck or Alnylam before submitting these arguments.”); see also Corrected Affidavit of Joern Erselius (Dkt. #26) ¶¶ 18–27; Affidavit of Wolfgang Weiss (Dkt. #12) ¶¶ 4–5.)

For example, the litigation papers explain how Whitehead has breached the Agreements by not taking into account the advice of Max-Planck and by not honoring important commitments made to Max-Planck regarding the use in the Tuschl I applications of data separately generated by the inventors named on the Tuschl II applications (a separate family of applications based on the work of Thomas Tuschl, one of the inventors named on the Tuschl I applications, and two other individuals not named as co-inventors on the Tuschl I applications). The assertion at page 2 of the

Opposition that Max-Planck “failed” to disclose the Agreements in the Max-Planck Petition ignores the fact that those Agreements were discussed in the papers from the litigation that Wolf Greenfield had already filed in the USPTO. As such, there was no need for the undersigned to file and discuss a duplicate set of those papers.

Moreover, the Agreements state that Whitehead has “primary” responsibility, not “exclusive” responsibility, for the prosecution of the Tuschl I applications. See Paragraph 1.(a) of Exhibits A and B of the Opposition. There is nothing in the Agreements that prevent Max-Planck from concluding that its interests are not being adequately represented and choosing to appoint different counsel. Max-Planck has made that decision and is requesting the USPTO to allow it to have that different counsel. The existence of the Agreements is not an irrevocable license to Wolf Greenfield to favor the interests of certain co-assignees over another.

The Opposition argues that “Max-Planck must acknowledge that the submission of affidavits standing alone is not enough to require disqualification” because Rothwell Figg attorneys have also submitted affidavits in the litigation (Opposition, at p. 4). This argument misses the point. Wolf Greenfield is representing parties that are adverse to another party—Max-Planck—from which the firm holds a Power of Attorney. In contrast, Rothwell Figg has but one client—Max-Planck and has never attempted to represent the other co-assignees in this matter, and has no power of attorney from the other co-assignees.

Thus, it is not just that Wolf Greenfield attorneys have submitted declarations; it is that the declarations they have submitted take positions directly contrary to the interests of Max-Planck. The Opposition also complains that the Max-Planck Petition

does not identify “any specific statement made by Ms. Lockhart or Ms. Granahan or explained how any such statement was contrary to its legitimate interests.” (Opposition, at p. 4.) Max-Planck challenges Whitehead to show any statement in those declarations that was NOT contrary to the interests of Max-Planck. Those declarations were submitted in *opposition* to Max-Planck’s Motions for a Preliminary Injunction and Temporary Restraining Order. How could they not be contrary to the interests of Max-Planck?

The pending suit against the co-assignees is based on Max-Planck’s exclusive ownership of information in the Tuschl II applications that has been wrongfully included in and not removed from, the Tuschl I applications. The PTO is not the forum for determining that issue. See *In re Barrison*, Proceeding No. D08-09 at paragraph 17 (Appendix C):

The USPTO is not the appropriate forum for resolving a dispute concerning the ownership of a patent application or invention.

Max-Planck is seeking resolution of that ownership issue in an appropriate forum. Wolf Greenfield, on the other hand, is attempting to moot the ownership suit by pursuing the issuance of the Tuschl I applications containing the disputed subject matter—information from the Tuschl II applications that should be removed from the TI applications. It is clear from the litigations that the relevant facts are in dispute. The USPTO cannot reasonably make a decision on the pending application claims until the litigations are resolved, unless all parties agree that an application is ready for issuance.

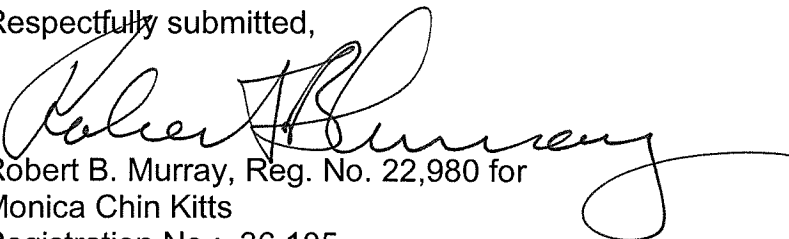
Allowing Max-Planck to appoint attorneys that will represent Max-Planck, rather than being adverse to Max-Planck, is the only appropriate action under the current circumstances. Max-Planck does not want to block all further prosecution, but merely to

make certain that its concerns are reflected in any papers submitted to the USPTO, and that its interests are adequately and competently represented before the USPTO.

Wolf Greenfield has admitted that it is advising the other co-assignees in the dispute with Max-Planck. That, by itself, is sufficient cause under 37 CFR 1.36(a) for Max-Planck's Petition to be granted.

Please charge the petition fee set forth in 37 CFR 1.17(f), and any and all fees associated with this petition to Deposit Account No. 02-2135.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert B. Murray", with a long horizontal flourish extending to the right.

Robert B. Murray, Reg. No. 22,980 for  
Monica Chin Kitts  
Registration No.: 36,105  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
SUITE 800, 1425 K STREET, N.W.  
WASHINGTON, D.C. 20005  
TELEPHONE: 202 783 6040



## EXHIBIT A

@PFDsktop: C:\PMA\HODMA\HBSR05, iManage, 453600, 1  
AJC jcc  
February 18, 2004

PATENT APPLICATION  
DOCKET NO. 0399.2008-002

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas Tuschl, Phillip D. Zamore, Phillip A. Sharp and David P. Bartel

Application No.: 09/821,832 Group Art Unit: 1637

Filed: March 30, 2001 Examiner: S. Chunduru

Confirmation No.: 6240

Title: RNA Sequence-Specific Mediators of RNA Interference

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on.	
3/31/04	<i>Jenine Crump</i>
Date	Signature
<i>Jenine Crump</i>	
Typed or printed name of person signing certificate	

REVOCATION OF POWERS OF ATTORNEY  
AND APPOINTMENT OF NEW ATTORNEYS AND/OR AGENTS  
AND CHANGE OF CORRESPONDENCE ADDRESS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.**, a Corporation duly organized under the laws of the Country of the Federal Republic of Germany, is an assignee of the entire right, title and interest in the above-identified application, along with, **Whitehead Institute for Biomedical Research**, a Corporation duly organized under the laws of the State of Delaware, **University of Massachusetts Medical Center**, a Corporation duly organized under the laws of the Commonwealth of Massachusetts, and **Massachusetts Institute of Technology**, a Corporation duly organized under the laws of the Commonwealth of Massachusetts. **Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V.** hereby appoints the attorneys and/or agents associated with:

09/821,832

-2-

**Customer No. 23628**  
Wolf, Greenfield & Sacks, P.C.  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, MA 02210  
Tel: +1.617.720.3500/ 617-573-7859  
Fax: +1.617.720.2441  
hlockhart@wolfgreenfield.com

to prosecute the above-identified application and any divisions or continuations thereof and to conduct all business in the United States Patent and Trademark Office. All previously granted Powers of Attorney are hereby revoked.

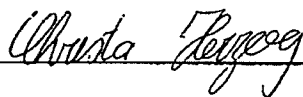
A Statement under 37 C.F.R. §3.73(b) is submitted herewith.

All correspondence should be sent to Customer No. 23628, Wolf, Greenfield & Sacks, P.C., 600 Atlantic Avenue, Boston, MA 02210. Please direct all telephone calls to Helen C. Lockhart, Ph.D. at 617-720-3500, and all facsimile communications to 617-720-2441.

Respectfully submitted,

**Max-Planck-Gesellschaft Zur Forderung  
Der Wissenschaften E.V.**

Name Christa Herzog

Signature 

Title Head of Patent Department

Date March 18, 2004

Docket No. 0399.2008-002

## STATEMENT UNDER 37 C.F.R. § 3.73(b)

Applicant(s): Thomas Tuschl, Phillip D. Zamore, Phillip A. Sharp and David P. Bartel  
 Application No.: 09/821,832 Filed: March 30, 2001  
 For: RNA Sequence-Specific Mediators of RNA Interference

Max-Planck-Gesellschaft zur Förderung der Wissenschaften E.V., a corporation  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is

- A. ☐ the assignee of the entire right, title and interest in the patent application identified above; or
- B. ☒ an assignee, together with, Whitehead Institute for Biomedical Research, Massachusetts Institute of Technology and University of Massachusetts Medical Center, of the entire right, title and interest in the patent application identified above. A separate Statement under 37 CFR § 3.73(b) is being submitted

The right, title and interest of the above-named assignee in the patent application identified above is established by virtue of:

- A. ☒ An assignment from Thomas Tuschl, co-inventor(s) of the patent application identified above. The assignment from Thomas Tuschl to Whitehead Institute for Biomedical Research and Max-Planck-Gesellschaft zur Förderung der Wissenschaften E.V. was recorded in the Patent and Trademark Office at Reel 012089, Frames 0934-0937

OR

- B. ☐ A chain of title from the inventor(s) of the patent application identified above, to the current assignee as shown below

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy thereof is attached
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy thereof is attached
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature: Christa Herzog  
 Name: Christa Herzog  
 Title: Head of Patent Department  
 Date: March 18, 2004

## EXHIBIT B

June 25, 2009

**VIA EMAIL**  
**mone@ebelaw.com**

Michael E. Mone  
Esdaile, Barrett & Esdaile  
Counselors at Law  
75 Federal Street  
Boston, MA 02110-1904

Re: Tuschl I Applications  
Our File No. W0571.90000US00

Dear Mr. Mone:

I have been asked to respond to your letter of June 24, 2009 to Timothy J. Oyer.

The Whitehead Institute retained Wolf Greenfield in connection with prosecuting the Tuschl I Applications. Wolf Greenfield does not have, and has not had, an attorney-client relationship with either of your clients. To the extent that your clients have an interest in the prosecution of those applications, they have by contract agreed that Whitehead would manage that prosecution. Wolf Greenfield bills Whitehead for its services in that prosecution. Any payments that your clients make have been to Whitehead as reimbursement.

In formulating the Joint Invention and Joint Marketing Agreement, the owners of the Tuschl I and II families recognized that those owners could have internecine differences as to how those patents should be prosecuted. That agreement dealt with that concern by allocating management and primary responsibility for prosecution of the Tuschl I family to Whitehead and prosecution of the Tuschl II family to an agent of Max-Planck. Each managing entity selects its own counsel to conduct its assigned prosecution. Whitehead retained Wolf Greenfield as its attorneys to prosecute the Tuschl I family. Max-Planck retained Rothwell Figg to prosecute the Tuschl II family.

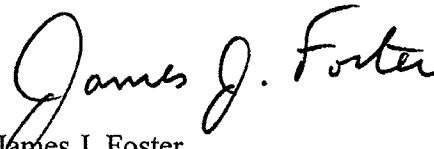
Your clients know full well that Wolf Greenfield does not have an attorney-client relationship with them and that Wolf Greenfield has been advising Whitehead with respect to Whitehead's dispute with your clients. I have myself been involved, on behalf of Whitehead, in adverse discussions with attorneys from Rothwell Figg representing your clients.

Michael E. Mone  
June 25, 2009  
Page 2 of 2

We will pass along to Whitehead your request that we take no action with respect to any Tuschl I application and request instruction.

Sincerely yours,

WOLF, GREENFIELD & SACKS, P.C.

  
James J. Foster

JJF/ars

## EXHIBIT C



**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE USPTO DIRECTOR**

In the Matter of	)	
	)	
Flynn H. Barrison,	)	
	)	
Respondent	)	Proceeding No. D08-09
_____	)	

**Final Order**

Office of Enrollment and Discipline Director Harry I. Moatz ("OED Director") and Flynn H. Barrison ("Respondent") have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("USPTO Director") or his designate for approval.

The OED Director and Respondent's Proposed Settlement Agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily a disciplinary complaint against Respondent. The Proposed Settlement Agreement, which satisfies the requirements of 37 C.F.R. § 11.26, resolves all disciplinary action by the United States Patent and Trademark Office ("USPTO" or "Office") arising from the stipulated facts set forth below.

Pursuant to such Proposed Settlement Agreement, this Final Order sets forth the parties' stipulated facts, legal conclusions, and agreed upon discipline.

**Jurisdiction**

1. At all times relevant hereto, Respondent of New York, New York, has been an agent registered to practice before the United States Patent and Trademark Office ("USPTO" or "the Office") and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 CFR § 10.20 et seq.

2. The USPTO Director has jurisdiction over this matter pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 11.26.

**Stipulated Facts**

3. Since July 22, 2003, Respondent of New York, New York, has been an agent registered to practice patent law before the Office (Registration Number 53,970) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 et seq.

4. At all relevant times, Respondent was employed under the supervision of a more senior registered patent agent or patent attorney.

5. In or around early February 2006, Respondent prepared for a client's signature a "Revocation of Power of Attorney with New Power of Attorney and a Change of Correspondence Address" and a "Statement Under 37 C.F.R. 3.73(b)" for three U.S. Patent Applications.

6. Each "Statement Under 37 C.F.R. 3.73(b)" expressed that the client was assignee of the entire right, title, and interest of the patent applications. The representation was false.

7. At the time the client signed the documents, Respondent was aware of an assignment of record showing that the client was assignee of record of only 98% of the right, title, and interest and brought such fact to the attention of an experienced registered patent attorney employed at the same firm as Respondent. Respondent referenced the reel and frame numbers for that assignment in the documents he filed in the Office. Respondent was also aware that the client was involved in litigation concerning the remaining 2% ownership interest. In preparing and filing the aforementioned documents, Respondent relied on statements made by the experienced registered patent attorney, who was representing the client in the litigation over the disputed 2% ownership interest. That attorney informed Respondent, "The fact of the fraudulently retained 2% interest is the central basis for the lawsuit we just filed against the inventor and the patent attorney."

8. Respondent did not research the issue of whether, under the facts known and available to him, Respondent could properly file the aforementioned documents with the USPTO.

9. Respondent mistakenly believed that the client could properly file the aforementioned documents in the Office and did not intend to mislead the Office.

10. On February 13, 2006, Respondent filed the aforementioned documents with the USPTO via facsimile transmission under Certificates of Transmission under 37 C.F.R. 1.8 bearing Respondent's signature.

11. On February 26, 2006, the inventor filed in the USPTO a "Request to Refuse Demands for Revocations of Power of Attorney with New Powers of Attorney and Changes in Correspondence Address" objecting to the attempted change of power of attorney.

12. On April 6, 2006, the USPTO issued an Office communication concerning each of the three applications stating that the "Revocation of Power of Attorney with New Power of Attorney and a Change of Correspondence Address" had not been accepted because it had not been signed by the applicant/inventor or by the assigned of record of the entire interest.

13. On July 7, 2006, a "Petition Under 37 C.F.R. § 1.183 by Third-Party to Patent Office Proceedings to Permit Action by Assignee Having an Of-Record 98% Interest" was filed in the Office on behalf of the client in one of the applications.

14. On November 8, 2006, a "First Supplemental Statement in Support of Petition Under 37 C.F.R. § 1.183 by Third-Party to Patent Office Proceedings to Permit Action by Assignee Having an Of-Record 98% Interest" was filed in the Office on behalf of the client.

15. On November 19, 2006, the named inventor filed in the USPTO an "Opposition to Petition Under 37 C.F.R. 1.83 to Permit Action By Assignee of A 98% Interest."

16. On December 12, 2006, the USPTO dismissed the petition because there was insufficient basis for allowing a third-party to have standing to object to the way in which the UPSTO treats the patent application of others.

17. The USPTO is not the appropriate forum for resolving a dispute concerning the ownership of a patent application or invention.

### **Legal Conclusion**

18. Based on the information contained in paragraphs 3 through 17, above, Respondent acknowledges that his conduct violated 37 C.F.R. § 10.23(b)(4) by submitting papers in the Office containing a false representation of ownership and 37 C.F.R. § 10.77(b) by filing papers in the Office without preparation adequate under the circumstances.

### **Sanction**

19. Respondent agreed, and it is ORDERED that:

- a. Respondent be suspended from practicing patent, trademark and other non-patent law before the Office for six (6) months and that all six months of the suspension be immediately stayed;
- b. Respondent serve a six-month probationary period commencing on the date on which this Final Order is signed;
- c. Respondent not sign (electronically or otherwise) any paper filed in the Office for a six-month period commencing on the date on which this Final Order is signed;
- d. Respondent may use his Public Key Infrastructure ("PKI") certificate number for electronically mailing papers to the Office that have been signed by other registered practitioners;
- e. the OED Director publish this Final Order;
- f. the OED Director publish the following Notice in the *Official Gazette*:

### **Notice of Suspension**

Flynn H. Barrison of New York, New York, an agent whose registration number is 53,970, has been suspended for six months with the entirety of the suspension stayed; restricted for six months from signing electronically or otherwise any paper filed in the Office; and placed on probation for six months by the

United States Patent and Trademark Office for violating 37 C.F.R. § 10.23(b)(4) by signing and filing papers in the Office on behalf of a client containing a false representation of ownership and 37 C.F.R. § 10.77(b) by signing and filing papers in the Office without preparation adequate under the circumstances. Mr. Barrison filed "Revocation of Power of Attorney with New Power of Attorney" and "Change of Correspondence Address" forms containing the representation that the client was the owner of the entire right, title, and interest in certain patent applications. In fact, the client was the assignee of record of only 98% of the ownership interest and was involved in litigation with the inventor over the remaining 2% interest. Prior to filing aforementioned documents in the Office, Mr. Barrison did not adequately research the issue of whether, under the facts known and available to him, he could properly assert that the client was the owner of the entire intellectual property interest. Instead, Respondent mistakenly relied on the statements made by a more experienced patent attorney representing the same client. There was insufficient evidence that Mr. Barrison intended to mislead the Office. The USPTO, however, is not the appropriate forum for resolving a dispute concerning the ownership of a patent application or invention. This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. §§ 11.26 and 11.59. Disciplinary decisions regarding practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at:  
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- g. in accordance with 37 C.F.R. § 11.59, the OED Director give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public; and
- h. (1) in the event that the OED Director is of the opinion that Respondent, during the six-month probationary period, failed to comply with paragraphs 19.c. or 19.d., above, and/or any current or future Disciplinary Rules of the USPTO Code of Professional Responsibility, the OED Director shall issue to Respondent an Order to Show Cause why Respondent should not be suspended for up to six (6) months, send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to § 11.11(a), and grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and


- (2) in the event after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be

of the opinion that Respondent, during the six-month probationary period, failed to comply with paragraphs 19.c. or 19.d., above, and/or any current or future Disciplinary Rules of the USPTO Code of Professional Responsibility, the OED Director shall: (a) deliver to the USPTO Director or his designate for imposition of an immediate suspension: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, and (iii) evidence causing the OED Director to be of the opinion that during the six-month probationary period that Respondent failed to comply with paragraphs 19.c. or 19.d., above, and/or any current or future Disciplinary Rules of the USPTO Code of Professional Responsibility and (b) request that the USPTO Director suspend Respondent for up to six months;

- i. in the event that the USPTO Director suspends Respondent pursuant to this Final Order and Respondent seeks a review of the USPTO Director's decision to suspend Respondent, any such review shall not operate to postpone or otherwise hold in abeyance the immediate suspension of Respondent;
- j. if Respondent is suspended during any portion of his six-month probationary period pursuant to the terms of this Final Order, Respondent shall comply with 37 C.F.R. § 11.58;
- k. if Respondent is suspended during any portion of the six-month probationary period pursuant to the terms of this Final Order, the OED Director shall comply with 37 CFR § 11.59;
- l. nothing in the proposed Settlement Agreement or this Final Order shall limit the number of times during the six-month probation that Respondent may be suspended pursuant to this Final Order;
- m. nothing in the proposed Settlement Agreement or this Final Order shall prevent the Office from seeking discipline against Respondent for the same misconduct that causes a suspension pursuant to any of the subparagraphs above;
- n. that the record of this disciplinary proceeding, including this Final Order, be considered: 1) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or 2) in any future disciplinary proceeding: a) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or b) to rebut any statement or representation by or on Respondent's behalf; and
- o. the OED Director and Respondent bear their own costs incurred to date and in carrying out the terms of this agreement.

JUN 18 2009

Date

  
James A. Toupin  
General Counsel

United States Patent and Trademark Office

on behalf of

John J. Doll  
Acting Under Secretary of Commerce for  
Intellectual Property and Acting Director of the  
United States Patent and Trademark Office

cc:

Harry I. Moatz  
Director Office of Enrollment and Discipline  
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